

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 21-27 and 29-31 are now in the application. Claim 31 has been amended.

Claim 28 has been canceled. Claims 1-10 and 11-20 had been previously canceled.

Claim Objections

The Examiner's careful review of the application is appreciated. The comments concerning claims 28 and 31 were persuasive and, accordingly, claim 28 has been canceled. The dependency of claim 31 has been adapted.

Claim Rejections – 35 U.S.C. § 112

The terms "substantially" and "about" are perfectly acceptable terms in patent claims to enable applicants to encompass a certain range of allowable deviations from an otherwise restrictive claim limitation. Such terms are read, however, with a view to how a person of skill in the art would read them and, in addition, with a view to "common sense." By way of example, claim 24 calls for an angle α of "about 89.5° with said drill axis." In addition, claim 21 defines the same angle as amounting to "less than 90°." That is, the angle 89.5° deviates upward to no more than just less than 90°. In a common sense reading, the allowable downward deviation would be understood to mirror the upward deviation. The angle of "about 89.5°" would therefore ensnare an infringer, who provided an angle of 89.5° exactly as well as an infringer with, say, 89.6° or 89.7° or even 89.8°. Similarly, the downward deviations would also be tested by reviewing similar sized steps of approximately 0.1°. Had

applicants claimed "89.597°" for example, the testing steps would logically be selected to be much smaller than 0.1°. Furthermore, the certainty of ensnaring an infringer would decrease with increasing distance from the exactly recited number.

We agree with the Examiner's statement that any reference that teaches an "angle and/or shape reasonably close" to those of the claims could be read on the claims. In quoting the Examiner, we emphasized the term "reasonably" in accord with the foregoing statements. We would further request that the Examiner deal with utmost care – as required – with issues such as "broadly interpreted and best understood by the Examiner." Broad interpretation must still be a reasonable interpretation. Best understanding by the Examiner must not be contrary to the understanding of one of skill in the art.

We respectfully request that the Examiner reconsider the rejection under 35 U.S.C. § 112, second paragraph. The terms "about" and "substantially" are properly used in the dependent claims and they are not indefinite. The specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved.

Claim Rejections – 35 U.S.C. §§ 102 and 103

Claims 21-26, 28, and 31 have been rejected as being anticipated by Salm et al. (US 4,607,988; hereinafter "Salm") under 35 U.S.C. § 102 or, in the alternative, as being obvious over Salm under 35 U.S.C. § 103. We respectfully traverse.

Salm does not anticipate the invention defined in claim 21. Claim 21 defines a cutting tool (for boring into solid material) with a front cutting edge that cuts "as far as said drill axis." Salm does not have a front cutting edge that is disposed to cut as far as the drill axis. 18714.181 m. 1

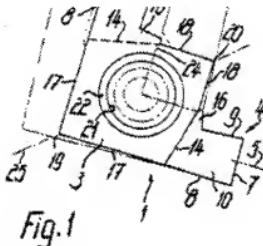


Fig. 1

First, the face 8 is not a cutting edge. Second, the face 8 lies behind the forward edge 17 of the cutting bit holder 2. That is, even if the face 8 were read on the claimed "front cutting edge," then that

front cutting edge could still not cut to the axis of the cutting bit. At most, it would only cut along that part of the insert that projects laterally outwardly from the side of the cutting bit holder. The adjacent face 7 has been read by the Examiner on the claimed "straight lateral cutting edge." While this would not necessarily appear unreasonable, it is noted that such cutting edge in Salm would not be suitable for "cutting the wall of a bore" because Salm's device is not suitable for drilling a bore.

The Examiner's attention is respectfully directed to Figs. 2 and 4, where the dash-dotted circles 27 and 27a show the outlines for cutting with the cutting edge 12, and 12', respectively.

Salm is entirely clear that the segment 17 of the insert forms the support surface in the base body of the tool. To wit:

Edge faces of body 3 serve as bearing faces 17, 18 for the orientation and supporting with respect to the cutting bit holder 2 The two outer bearing faces 17 form flat extensions of the outer side faces 8 of

projections 4, are at right angles to one another and pass into one another in a corner angle 19 of body 3.

Salm, col. 5, lines 44-46. That is, the surface 17 is clearly not a cutting edge.

The end of the cutting edge region with the formation of an inclined tool face for the chip removal is illustrated in Fig. 1 and identified with the numeral 14. Following that region, the cutting insert has no further cutting face that would be suitable for machining – which is also illustrated in Figs. 2 and 4 – and which is further supported by the fact that Salm refers to the element 17 as a "bearing face" and that it simply is not a cutting edge.

As noted above, the tool of Salm is not suited for boring into solid material. Instead, it is solely and exclusively intended for internal turning or external turning. Col. 4, lines 27-29.

Furthermore, there is no suggestion to be found in Salm that would prompt a person of skill in the art to lengthen a cutting edge, transversely to the tool axis, to reach all the way to the axis. The modification towards the claimed invention is therefore not obvious either.

The additional references Holmes et al. '672 and JP 101 56 604 have been reviewed as well. No combination of the secondary references with the primary reference Salm could render the claimed invention obvious. The core element of a forward cutting edge that is disposed to cut all the way to the tool axis is lacking from the secondary references as well.

In summary, none of the references, whether taken alone or in any combination, either show or suggest the features of claim 21. Claim 21 is, therefore, patentable over the art and since all of the dependent claims are ultimately dependent on claim 21, they are patentable as well.

In view of the foregoing, reconsideration and allowance of claims 21-27 and 29-31 are solicited.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner Greenberg Stemer LLP, No. 12-1099.

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